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10/030,303	06/03/2002	Marc Saelen	10541-927	8786

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EXAMINER

COMPTON, ERIC B

ART UNIT PAPER NUMBER

3726

DATE MAILED: 08/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/030,303	Applicant(s) SAELEN ET AL.	
	Examiner Eric B. Compton	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/15/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. 4,243,456 to Cesano.

Regarding claim 1, Cesano disclosed a process for forming a planiform piece intended for an interior fitting of a motor vehicle (see Figure 6), the process comprising:

covering at least one layer of at least one face along a portion (in vicinity of 143) of a support material (10) with a cladding (11);

cutting (with blade 141) along said portion such that said cladding (11) projects from said support material (10) in said portion;

pre-positioning a cutting tool (151) between said cladding (11) and said support material (10) along said portion; and

cutting along said portion with said cutting tool (151) when said support material (10) is covered with said cladding (11), simultaneously while forming a laminate.

Regarding claims 2-7, the dependant limitations are anticipated by Cesano, as well.

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Regarding claim 8, Cesano further discloses a device for forming a planiform piece for an interior fitting of a motor vehicle (see Figure 6), the device comprising:

a covering means (12,14) for covering a layer of support material (10), on at least one face and in a portion (in vicinity of 143) of said support material with a cladding (11), wherein said covering means changes from a first configuration to a second configuration (i.e., open or closed);

a cutting means (151) for cutting said support material (10) along said portion such that said cladding (11) projects beyond said support material in said portion, and

wherein said cutting means (151) is adaptable for being positioned between said cladding (11) and said support material (10), along said portion, and cutting said support material (10) along said portion (in vicinity of 143) when the covering means changes from said first to said second configuration.

Note: Cesano's device corresponds identically with the third embodiment of Applicant shown in Figure 3.

Regarding claim 9, this dependant limitation is anticipated by Cesano, as well.

Regarding claims 10-11, Cesano discloses: the first positioning means (tip of 15, see Figure 2); second positioning means (top surface of 15); and third positioning means (188 pushes 15), consistent with that of the embodiment of Applicant shown in Figure 3.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cesano in further view of U.S. Pat. 4,991,478 to Riley.

Note: Claim 12, requires that "third positioning means (23) for positioning cutting tool (5) includes a support (24) articulated in relation to an intermediate member (25) for co-operating with at least one of the punch (11) and the die (12)." According to the Specification, this corresponds to the embodiments shown only in Figures 1, 2, and 4. Page 7, lines 26-28.

Cesano discloses the invention cited above consistent with that of the embodiment of Applicant shown in Figure 3. However, Cesano does not disclose the third positioning means for positioning cutting tool includes a support articulated in relation to an intermediate member for co-operating with at least one of the punch and the die.

Riley discloses a device for forming a planiform piece for an interior fitting of a motor vehicle (see Figure 1). Riley wishes to trim the edge of the planiform to remove a portion a support material (22) while covered with a covering material (26). See Col. 3, lines 45-55; Col. 5, lines 3-8.

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In FIG. 3, the cutting position is shown in solid lines and the open position in dashed lines. Actuator 62 (FIG. 2), which may be hydraulic, pneumatic, mechanical or electromechanical, moves the blade fixture between the two positions. In the open position, the workpiece may be readily inserted for trimming or removed after trimming. In the closed position the blades are oriented generally vertically for cutting. Rollers 58 are seen in FIG. 2 in contact with the blade segments. The rollers are pressed into contact with blade segments 42 by pneumatic or mechanical actuators 64, which apply pressure to the rollers.

See Col. 4, lines 55-66. This embodiment generally corresponds to the embodiments of Applicant shown in Figures 1, 2, and 4. Thus, Riley discloses third positioning means for positioning cutting tool (42) that includes a support (70) articulated in relation to an intermediate member (32) for co-operating with at least one of the punch (30) and the die (36). A second embodiment of the invention, discloses a translational cutting tool, akin to Cesano and the embodiment of Applicant shown in Figure 3. See Figures 6-7.

Regarding claim 11, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Cesano with third positioning means for positioning cutting tool that includes a support articulated in relation to an intermediate member for co-operating with at least one of the punch and the die, in light of the teachings of Riley, since a translational cutting tool and articulated cutting tool are equivalent means. See *In re Ruff*, 256 F.2d 590, 598 (CCPA 1958) (holding prima facie obviousness of equivalence may be suggested by prior art).

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Regarding claim 13, Riley disclose a jack (62) acting on the cutting tool support (70) for applying a pressure to a cutting portion; and the mold includes an applying means (58) for applying pressure to the cutting portion.

Regarding claims 14-15, in Riley, pressing means (64), including stops/roller (58 having cam surfaces) for applying to the support (70) and cutting tool (42) is provided. This is an obvious equivalent of Applicant pressing means. A closing means (40) is also provided for closing the mold (38).

Regarding claim 16, in Riley the roller (58) having cam surfaces is believed to function equivalently to Applicant's wedges.

Regarding claim 17, Riley suggests the use of elastic return means to cause the cutting tool to "spring back into their resting positions after cutting." See Col. 6, lines 63-65.

Response to Arguments

5. Applicant's arguments filed June 15, 2004 ("Response"), have been fully considered but they are not persuasive.

Applicant argues that

While Cesano discloses a method for forming a laminate, Cesano does not disclose simultaneously laminating a cladding sheet to a support material and cutting said support material. Cesano discloses first laminating a flexible film to a substrate layer and then through additional and subsequent steps, cutting the substrate layer, as depicted In Figures 1-3. The present invention advantageously provides simultaneous forming and cutting of a support material and cladding sheet in a single operation.

Response, page 10. With respect to Cesano Applicant notes,

Cesano discloses a method for laminating inner door panels for an automobile. An upper and lower mold member are moves towards each other to mold a substrate layer and a coating layer (column 7, lines 15-24). After full compression of a pair of resilient elements and upon further downward movement of a press platen, the threshold value of deformation of the resilient elements will be reached and eventually a cutting edge interacts with a shearing edge to cut off a margin portion to produce a substrate edge while maintaining the free edge portions of the coating layer (Column 7, lines 56-66).

Id. at page 9. Applicant then tries to distinguish the instant invention by indicated that the forming and cutting steps are preformed simultaneously. *Id.*

However, a review of the Specification reveals that Applicant's invention is performed in essentially the same manner as Cesano. "Said punch 11 and said die 12 are movable towards one another to enable the mould to be closed in a so-called 'forming' direction 14." Specification, page 4, lines 18-19. "Said support 1 and said cladding 4 are adhered to one another by closing said mould, in said forming direction 14, said support 1 and said cladding 4 being possibly formed simultaneously, according to the profile given to air gap 13. For this purpose, **thermocompression is used.**" *Id.* at page 4, line 33 to page 5, line 3 (emphasis added). "Cutting and closing of the mould can advantageously by co-ordinated by controlling the path of cutting tool 5 in relation to the relative path of die 12 and of punch 11 in such a way as to complete these two operations simultaneously. In other words, **said cutting will be carried out at the end of the closing movement** of mould 10 in said direction 14." *Id.* at page 5, lines 4-8 (emphasis added).

In Cesano, during forming compression of the layers is controlled by gradually increasing the force through resilient members (161, 162) and springs (182, 183) by movement of platen (18). Col. 7, lines 45-47. Once full compression of resilient

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members (161, 162) and springs (182, 183) is reached the platen (18) contacts the upper mold member (14) and they travel together with cutting element (15) moving downwardly as well. *Id.* at lines 56-66. Thus just like Applicant, the cutting (with the intermediate cutting member between the layers) is performed at the end of closing movement of the mold. According to Applicant is a simultaneous process.

Applicant also argues that Riley does not disclose "simultaneous forming and cutting." Response, page 11. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Examiner cited Riley for teaching that a translational cutting tool and articulated cutting tool are equivalent means in the art.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (703) 305-0240. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter B. Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Eric Compton

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Patent Examiner

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